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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 12
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re SnapTrack, Inc.

Serial No. 75/472,972

Lori N. Boatright of Blakely, Sokoloff, Taylor & Zafman for
SnapTrack, Inc.

Ronald E. Aikens, Trademark Examining Attorney, Law Office
103 (**Michael Szoke**, Managing Attorney).

Before Hohein, Chapman and Wendel, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by SnapTrack, Inc. to
register on the Principal Register the mark LOCATION ON
DEMAND¹ for "global positioning computer system hardware and
software for identifying the position and uses of a
telecommunication device" in International Class 9, and
"communications and telecommunications services using
global positioning systems to provide navigation,

¹ Application Serial No. 75/472,972, filed April 23, 1998, in
which applicant alleges a bona fide intention to use the mark in
commerce.

positioning, and tracking for a user of a telecommunications device" in International Class 38.²

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark, if used in connection with applicant's goods and services, is merely descriptive of them. The Examining Attorney also made final the requirement for a more definite identification of both the goods and the services.³

Applicant has appealed, and applicant and the Examining Attorney have briefed the issues before us. An oral hearing was not requested.

Turning first to the question of the identifications of goods and services, the Examining Attorney did not accept the original identifications of goods and services, and he offered suggested identifications for applicant's goods and services. In response, applicant amended the identifications of goods and services to that set forth above. Applicant's amendment to the identifications has been rejected by the Examining Attorney as indefinite.

² The acceptability of the identifications of goods and services is an issue in this appeal and will be fully addressed later in this decision.

³ There is no indication in this record that the Examining Attorney consulted the Administrator for Trademark Classification and Practice, or that a copy of the final Office action was referred to that Administrator pursuant to TMEP §804.06.

The Examining Attorney contends that the term "software" in the identification of goods and the words "communications and telecommunications services using global positioning systems..." in the identification services render the identifications indefinite. Specifically, the Examining Attorney contends that applicant has not identified the nature of the software components with enough specificity in its identification of goods; and that the identification of services is unclear as to whether applicant's services utilize a global positioning system to provide navigation and tracking or whether applicant provides a navigation and tracking service.

Applicant contends that both the identifications of goods and services meet the criteria of the "USPTO ID Manual" for making clear the nature of the involved goods and services.

Section 1(b)(2) of the **Trademark Act**, 15 U.S.C. §1051(b)(2), requires that the written application specify the goods or services in connection with which applicant intends to use the mark. Trademark Rule 2.32(a)(6) requires, in relevant part, that a trademark application must set forth "the particular goods or services" with which applicant uses or intends to use the mark. Further,

the identification of goods or services must be specific and definite. See TMEP §§804.01, and 1301.05. The TMEP also sets forth the guidelines which the Examining Attorney should consider in determining the appropriateness of any identification of goods or services.

Upon careful review of the information of record, we find that applicant's identifications of goods and services, while perhaps not as specific as the identifications suggested by the Examining Attorney, nonetheless sufficiently define both the goods on which and the services in connection with which applicant intends to use its mark. Thus, the refusals to register in the absence of further specification of the identifications of goods and services were improper.

Turning to the issue of descriptiveness, the Examining Attorney contends that the mark LOCATION ON DEMAND merely describes the purpose and function of applicant's identified goods and services involving global positioning system hardware and software communications and telecommunications services using global positioning systems. The Examining Attorney specifically argues as follows:

The plain definitions of the terms clearly indicate the functions and characteristics of the goods and

services - to supply a consumer with information as to their location when needed or asked for. In other words, the applicant's goods and services are designed to provide a consumer with their *location on demand*. (Emphasis in original.) (Final Office action, p. 2); and

The meaning of the mark can be understood from the individual meanings of its elements - the plain meaning of "LOCATION ON DEMAND" is that one asks to be informed of the place where something is or could be located. The combination of the words does not have a different meaning from those of the individual words. (Brief, p. 9.)

In support of the descriptiveness refusal, the Examining Attorney has made of record the following definitions from The American Heritage Dictionary (1992):

- (1) "location" is defined as "2. A place where something is or could be located; a site"; and
- (2) "demand" is defined as "3. To ask to be informed of: I demand a reason for this interruption," and it includes a further definition of "-idiom. on demand 2. When needed or asked for: fed the baby on demand."

Applicant argues that the mark LOCATION ON DEMAND is not a common descriptive name of the goods or services and does not have a clear meaning; that the mark is "nebulous" in meaning and thus, is only suggestive of the goods and services; that because the "on demand" portion of the mark

is idiomatic, it is, by definition,⁴ peculiar to the language, and when the word "location" is added, the mark creates a unique combination of words; that the Examining Attorney has not provided any evidence of the mark actually used by others in connection with any such goods or services; and that doubt on the issue of descriptiveness must be resolved in favor of applicant.

The test for determining whether a mark is merely descriptive is whether the term immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection

⁴ Applicant requested in its brief that the Board take judicial notice of the following definition of the term "idiom" from The American Heritage College Dictionary (1997): "a speech form or an expression of a given language that is peculiar to itself grammatically or cannot be understood from the individual meanings of its elements." Applicant's request is granted. See TBMP §712.

with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985). Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990).

We agree with the Examining Attorney that applicant's mark immediately and directly conveys information about a significant purpose and function of applicant's goods, i.e., that, when needed or asked for, applicant's global positioning system computer hardware and software identifies something's position or location, and the communications and telecommunications services using global positioning systems provide positioning or location information.

The ordinary, commonly understood meaning of the words LOCATION ON DEMAND, considered as a whole, and in the context of applicant's goods and services (involving global

positioning systems) immediately informs prospective purchasers that applicant's goods and services are intended as a product and a service to assist, as needed or when asked, in identifying and/or tracking a position (location). Thus, when the mark LOCATION ON DEMAND is viewed in the context of applicant's goods and services, the purchasing public would immediately understand the nature and purpose of the goods. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Omaha National Corporation*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Applicant's mark is not incongruous, creates no double meaning, and requires no imagination or thought in order to ascertain its meaning in relationship to applicant's identified goods and services. The fact that a part of the mark ("on demand") is idiomatic in the English language serves to heighten the commonly understood meaning of the mark in the context of applicant's goods and services. Purchasers would immediately understand that these goods and services involve the act or process of locating something or someone when the consumer requests the information.

Applicant's argument that there is no evidence of other users of these words is not persuasive. In order to show that that a mark is merely descriptive, it is not necessary to show that others are using it. It is well established that a term may be merely descriptive even if applicant is the first or is the only entity currently using it. See *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994); and *Pennzoil Products*, supra at 1756.

Decision: The refusal based on the requirement for an acceptable identification of goods and services is reversed. The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) is affirmed.